

D-2959CIP

9

REMARKS

The above-identified application has been carefully reviewed in light of the Examiner's communication mailed June 19, 2003. Applicant submits that the amendments and remarks included herein show all of the present claims to be allowable. Therefore, applicant respectfully requests that this Response B be entered and considered on its merits.

Applicant gratefully acknowledges the Examiner's holding that claims 12 to 41, 45 and 46 are allowable.

Claims 1 and 42 have been amended to provide that the matrix remains at least about 50% insoluble in the fuel during and after the recited contacting step. Such amendments are fully supported by and consistent with the present specification, for example by Table 1 on page 25 of the present specification.

The Examiner contends that claims 47 to 55 are directed to distinct inventions and that the first invention has been constructively elected by the original presentation for prosecution on the merits. Applicant traverses this holding.

However, in order to facilitate the prosecution of the above-identified application, applicant has canceled claims 47 to 55, without prejudice. Applicant expressly reserves the right to seek patent protection for claims 47 to 55 and/or similar claims in one or more later filed related applications.

Claims 1 to 5, 8 to 11 and 42 to 44 have been rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which is not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicant traverses this rejection as it pertains to the present claims.

As set forth in claim 1, the present invention is directed to methods of releasing a fuel additive into a fuel. Such methods comprise providing a fuel filter containing a fuel additive combined with a matrix material in a fuel additive composition. The fuel additive is distributed in the matrix material and is

D-2959CIP

10

effective when released into a fuel to provide at least one benefit to the fuel.

The fuel filter is positioned between a source fuel and an internal combustion engine. The method further includes contacting a portion of the fuel additive composition with a portion of the fuel to provide fuel compositions comprising the fuel additive dissolved in the portion of the fuel. The fuel composition is allowed to admix with the fuel. The matrix material remains at least about 50% insoluble in the fuel during, and preferably after, the above-noted contacting step.

As noted previously, Table 1 on page 25 of the above-identified application shows matrix materials that are at least about 50% insoluble in contact with fuel at different temperatures for different times.

Thus, applicant submits that the present rejected claims are clearly, directly and expressly supported by the above-identified application.

In view of the above, applicant submits that the presently rejected claims, that is claims 1 to 5, 8 to 11 and 42 to 44 satisfy the requirements of 35 U.S.C. 112, first paragraph. Therefore, applicant respectfully requests that the rejection of these claims based upon the statutory provision be withdrawn.

In conclusion, the Examiner has held that claims 12 to 41, 45 and 46 are allowed. Applicant has shown that claims 1 to 5, 8 to 11 and 42 to 44, as amended, satisfy the requirements of 35 U.S.C. 112, first paragraph. Therefore, applicant submits that all of the present claims, that is claims 1 to 5 and 8 to 46 are allowable and

D-2959CIP

11

respectfully requests the Examiner to pass the above-identified application to issuance at an early date. Should any matters remain unresolved, the Examiner is requested to call (collect) applicant's attorney at the telephone number given below.

Respectfully submitted,



Frank J. Uxa
Attorney for Applicant
Reg. No. 25,612
4 Venture, Suite 300
Irvine, CA 92618
(949) 450-1750
Facsimile (949) 450-1764

FJUxa/ac

OFFICIAL

FAX RECEIVED

AUG 20 2003

TC 1700